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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,849	02/26/2002	Neal Zahn	WIN825/01830	6832
24118	7590	06/28/2004	EXAMINER	
HEAD, JOHNSON & KACHIGIAN			MARX, IRENE	
228 W 17TH PLACE			ART UNIT	
TULSA, OK 74119			PAPER NUMBER	

1651

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/082,849

Applicant(s)

ZAHN ET AL.

Examiner

Irene Marx

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The amendment filed 5/13/04 is acknowledged. Claims 1-10 are being considered on the merits.

Claims 11-16 are withdrawn from further consideration as directed to a non-elected invention.

This application contains claims 11-16 drawn to an invention nonelected with traverse in the reply filed on 11/22/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite in the recitation of “active humic compounds”. The activity of the humic compounds is not sufficiently delineated and cannot be readily determined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-6 are/remain rejected under 35 U.S.C. 102(b) as being anticipated by Richards *et al.* for the reasons as stated in the last Office action and the further reasons below.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant argues that the intended use of the composition is different from that of Richards *et al.*. However, the claims under examination are not directed to a process, but rather to a composition. Therefore, the intended use is given little weight. Applicant has not indicated that any difference in intended use alters the nature composition in this instance.

Applicant also argues that the reference does not address the specific organism(s) to be used. It is noted that the only claim that identifies microorganisms in the composition are claim 3, and now dependent claim 7, which include saprophytic *Bacillus* from broad species designations which are known to be abundant in nature. In addition, these claims are not part of the rejection.

Richards *et al.* specifically address the aerobicity of the beneficial saprophytic strains by indicating that if nitrogen fixing organisms are absent, they should be inoculated and "activated by aerobic contact with a nitrogenous solution" (See, e.g., col. 3, lines 23-29) In the even that anaerobic microorganisms are used, they would be instantaneously killed by contact with air. Thus, it would have been clear to one of ordinary skill in the art at the time the claimed invention was made that aerobic microorganisms are intended and used in the composition disclosed by the reference.

Therefore the rejection is deemed proper and it is adhered to.

Claims 1-6 and 8-10 are/remain rejected under 35 U.S.C. 102(b) as being anticipated by Ely *et al.* (U.S. Patent No. 3,151,983) for the reasons as stated in the last Office action and the further reasons below.

***Response to Arguments***

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

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The arguments by counsel that the reference does not appear to suggest humic or humatic products as the result of the fermentation is noted. The arguments by counsel in this regard have not been substantiated with appropriate objective evidence. It is well settled that arguments by counsel do not constitute evidence. There is no indication of record that wheat bran differs in intrinsic composition with respect to humic or humatic products from wheat straw, respectively, ground barley and whole barley grain. The fact that the humic factors attributable to the degraded straw work optimally in an aquatic environment is noted. However, this is not the invention claimed.

Therefore the rejection is deemed proper and it is adhered to.

Claims 1-10 are/remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ely *et al.* taken with Richards *et al.* and Jeffreys for the reasons as stated in the last Office action and the further reasons below.

#### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicant's arguments regarding Ely *et al.* and Richards *et al.* are addressed *supra*.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, all of the references are directed to compositions produced by fermentation comprising an organic matrix of a similar constitution and comprising saprophytic bacteria, hydrolytic enzymes and humic compounds. Jeffreys is relied upon for teachings of a dried composition which appears to be granular at least to some extent. (See, e.g., Examples IV and IX). This material is disclosed as suitable for the treatment of aquatic environments, such as sewage. The saprophytic bacteria would reasonably be expected to include *Bacillus* (See, e.g., col. 4, lines 63-71).

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Furthermore, at least in claims 4-6 the composition is claimed as a product-by-process. Since the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make comparisons therewith, a lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional manner. MPEP 2113.

Applicant has not presented objective evidence to demonstrate unexpected properties of the composition as claimed to patentably distinguish the claimed composition over the combined teachings of the references. Therefore, the rejections are deemed proper and are maintained.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is 571-272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.



Irene Marx  
Primary Examiner  
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